

**REMARKS**

This Application has been carefully reviewed in light of the Final Office Action mailed December 15, 2005. In the Final Office Action, Claims 1-37 are pending and the Examiner rejects Claims 1-37. Applicants respectfully request reconsideration and favorable action in this case.

**I. Claims 1-8, 10-16, 32-33, and 35-36**

The Examiner rejects Claims 1-8, 10-16, 32-33, and 35-36 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,799,273 issued to Mitchell et al. ("Mitchell") in view of U.S. Patent Application Publication No. 2001/0013001 issued to Brown et al. ("Brown"). With regard to Claims 1-8, 10-16, 32-33, and 35-36, Applicants respectfully submit that the proposed *Mitchell-Brown* combination is improper.

**A. The Standard**

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143. The teaching, suggestion or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an Applicant's disclosure. *See Id.* (citations omitted). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See Id.* (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.<sup>1</sup> According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczkak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant’s disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, “The tendency to resort to ‘hindsight’ based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. “A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.’” *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the Federal Circuit noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, the court requires the Examiner to show a motivation to combine the references that create the case of obviousness. *See id. See also, e.g.,*

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<sup>1</sup> Note M.P.E.P. 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

*Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembicza*k, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

#### B. The Analysis

In the Final Office Action, the Examiner acknowledges that *Mitchell* "does not teach transmitting audio to a telecommunication device to play an audio file to a user." (Final Office Action, page 2). The Examiner speculates, however, that "it would have been obvious to one of ordinary skill at the time of the invention to modify the system of *Mitchell* to implement an interactive voice response system as suggested by *Brown*." (Final Office Action, page 3). Applicants respectfully submit that the Examiner's summary conclusion amounts to mere speculation and does not provide the suggestion or motivation necessary to make the proposed combination.<sup>2</sup> It appears that the Examiner has merely proposed alleged advantages of combining *Brown* with *Mitchell* (advantages which Applicants do not admit could even be achieved by combining these references in the manner the Examiner proposes). The Examiner has not pointed to any portions of the cited references, however, that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the telephone delivery of audio content as disclosed in *Brown* with the speech recognition engine of *Mitchell*. In other words, the alleged advantage of the system disclosed in *Brown* does not provide an

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<sup>2</sup> If the Examiner is relying on "common knowledge" or "well known" art in support of his rationale for combining *Mitchell* and *Dionne*, the Examiner is requested to produce a reference in support of his position pursuant to M.P.E.P. § 2144.03. If the Examiner is relying on personal knowledge to supply the required motivation or suggestion to combine *Mitchell* and *Dionne*, Applicants respectfully request that the Examiner produce an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention (*without using Applicants' claims as a guide*) to modify the particular techniques disclosed in *Mitchell* with the cited disclosure in *Brown*; (2) how one of ordinary skill in the art at the time of Applicants' invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Claim 1.

Indeed, if it were sufficient for Examiners to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law. Accordingly, Applicants respectfully submit that the Examiner's attempt to modify or combine *Mitchell* with the teachings of *Brown* appears to constitute the type of impermissible hindsight reconstruction of Applicants' claims, using Applicants' claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases. Applicants submit that the mere possibility that the interactive voice response system of *Brown* might improve the speech recognition engine of *Mitchell*, as the Examiner asserts, does not even remotely provide the required teaching, suggestion, or motivation to modify the teachings of *Mitchell*.

Furthermore, Applicants submit that it certainly would not have been obvious to one of ordinary skill in the art at the time of invention *to even attempt* to, let alone *to actually*, modify or combine the particular techniques disclosed in *Mitchell* with the telephone delivery of Internet content of *Brown* in the manner proposed by the Examiner.<sup>3</sup> It is essential to view the invention as a whole, taking each element into account as well as the advantages, properties, utilities, and results of the invention. *In re Chupp*, 816 F.2d 643, 2 U.S.P.Q.2d 1437 (Fed. Cir. 1987). As discussed above, it is the Examiner's position that "it would have been obvious to one of ordinary skill at the time of the invention to modify the system of *Mitchell* to implement an interactive voice response system as suggested by *Brown*." (Final Office Action, page 3).

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<sup>3</sup> If "common knowledge" or "well known" art is relied upon by the Examiner to combine or modify the references, Applicants respectfully request that the Examiner provide a reference pursuant to M.P.E.P. § 2144.03 to support such an argument. If the Examiner relies on personal knowledge to supply the required motivation or suggestion to combine or modify the references, Applicants respectfully request that the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

Applicants respectfully submit, however, that the provided motivations do not provide a suggestion to combine these two references.

Specifically, *Mitchell* is limited to a speech recognition engine that is used in data processing. (Column 1, lines 8-10). The principle and purpose of the speech recognition engine disclosed in *Mitchell* is to allow “audio data to be played back for any output data which has been dictated even if the data as a whole has been processed in such a way as to move, reorder, delete, insert or format the data.” (Column 1, lines 59-67). Accordingly, the speech recognition engine of *Mitchell* allows “audio data to be played back for any output data which has been dictated even if the data as a whole has been processed in such a way as to move, reorder, delete, insert or format the data.” (Column 1, lines 59-67). As a result, *Mitchell* is merely a modification of existing dictating software such as DragonDictate and merely replays dictated text to help a user performing proofreading functions. This objective is very different from the objective of *Brown*, which is to provide techniques “for extending Internet access to users equipped with only a telephone or other similar audio interface device.” (Page 1, paragraph 2).

In addition to *Brown* being outside the field of technology of *Mitchell*, there is no explicit or implicit reference in either reference which would suggest to one of ordinary skill to combine the speech recognition engine allowing proofreading functions disclosed in *Mitchell* with the telephone delivery of Internet content as disclosed in *Brown*. Stated differently, there is no reference in either reference as to why it would be obvious of one of ordinary skill in the art to incorporate delivery by telephone of Internet content (or any other content, for that matter) into the speech recognition engine providing proofreading functions disclosed by *Mitchell*. *Mitchell* in no way deals with or discusses obtaining or processing text or audio content from the Internet. As stated above, *Mitchell* is limited to a system for providing proofreading functions in the area of data processing. It is clear based at least on the many distinctions discussed above that the proposed *Mitchell-Brown* combination does not, taken as a whole, suggest the claimed invention, taken as a whole. Applicants respectfully submit that the Examiner has merely pieced together disjointed portions of unrelated references, with the benefit of hindsight using Applicants’ claims as a blueprint, in an attempt to reconstruct Applicants’ claims.

For at least these reasons, Applicants respectfully submit that the proposed *Mitchell-Brown* combination is improper. Applicants respectfully request reconsideration and allowance of Claims 1-8, 10-16, 32-33, and 35-35.

## **II. Claims 9, 17-31, 34, and 37**

The Examiner rejects Claims 9, 17-31, 34, and 37 under 35 U.S.C. § 103(a) as being unpatentable over *Mitchell* in view of U.S. Patent No. 6,068,487 issued to Dionne (“*Dionne*”) and further in view of U.S. Patent No. 6,424,357 issued to Frulla et al. (“*Frulla*”). Applicants reiterate the standard for the modification and combination of references that is discussed above with respect to Claims 1-8, 10-16, 32-33, and 35-36 and respectfully submit that the proposed *Mitchell-Dionne-Frulla* combination is improper.

With respect to *Dionne*, the Examiner speculates that “it would have been obvious” to “modify the system of *Mitchell* to provide the spelling of words in the text, to aid in the editing of recognized text and in the correcting of recognition errors, for the purpose of assisting individuals with visual impairments with editing of text.” (Final Office Action, page 7). With respect to *Frulla*, the Examiner similarly speculates that “it would have been obvious” to “modify the system of *Mitchell* to provide the spelling of words in the text, to aid in the editing of recognized text and in the correcting of recognition errors and to further provide voice command control, as suggested by *Frulla*, for the purpose of making the user interface more convenient and efficient for a user to input information and commands in situations in which using a physical mouse is impractical or cumbersome.” (Final Office Action, pages 7-8). Accordingly, it appears that the Examiner has again merely proposed alleged advantages of combining *Dionne* and *Frulla* with *Mitchell* (advantages which Applicants do not admit could even be achieved by combining these references in the manner the Examiner proposes). The Examiner has not pointed to any portions of the cited references, however, that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the spelling function of *Dionne* and the voice command function of *Frulla* into the speech recognition engine of *Mitchell*. In other words, the alleged advantage of the systems disclosed in *Dionne* and *Frulla* do not provide an explanation as to: (1) why it would have been obvious

to one of ordinary skill in the art at the time of Applicants' invention (*without using Applicants' claims as a guide*) to modify the particular techniques disclosed in *Mitchell* with the cited disclosures in *Dionne* and *Frulla*; (2) how one of ordinary skill in the art at the time of Applicants' invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Claim 1.

As discussed above, if it were sufficient for Examiners to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law. Applicants respectfully submit that the Examiner's attempt to modify or combine *Mitchell* with the teachings of *Dionne* and *Frulla* appear to constitute the type of impermissible hindsight reconstruction of Applicants' claims, using Applicants' claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases. Applicants submit that the mere possibility that the spelling function of *Dionne* and the voice command function of *Frulla* might improve the speech recognition engine of *Mitchell*, as the Examiner asserts, does not even remotely provide the required teaching, suggestion, or motivation to modify the teachings of *Mitchell*. Applicants respectfully submit that the Examiner's summary conclusions amount to mere speculation and do not provide the suggestion or motivation necessary to make the proposed combination.<sup>4</sup>

Furthermore, Applicants submit that it certainly would not have been obvious to one of ordinary skill in the art at the time of invention *to even attempt* to, let alone *to actually*, modify or combine the particular techniques disclosed in *Mitchell* with the spelling function of *Dionne* and the voice command function of *Frulla* in the manner proposed by the Examiner.<sup>5</sup> It is

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<sup>4</sup> If the Examiner is relying on "common knowledge" or "well known" art in support of his rationale for combining *Mitchell*, *Dionne*, and *Frulla*, the Examiner is requested to produce a reference in support of his position pursuant to M.P.E.P. § 2144.03. If the Examiner is relying on personal knowledge to supply the required motivation or suggestion to combine *Mitchell*, *Dionne*, and *Frulla*, Applicants respectfully request that the Examiner produce an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

<sup>5</sup> If "common knowledge" or "well known" art is relied upon by the Examiner to combine or modify the references, Applicants respectfully request that the Examiner provide a reference pursuant to M.P.E.P. § 2144.03 to support

essential to view the invention as a whole, taking each element into account as well as the advantages, properties, utilities, and results of the invention. *In re Chupp*, 816 F.2d 643, 2 U.S.P.Q.2d 1437 (Fed. Cir. 1987). As discussed above, it is the Examiner's position that "it would have been obvious" to modify the system of *Mitchell* "to provide the spelling of words in the text, to aid in the editing of recognized text and in the correcting of recognition errors and to further provide voice command control, as suggested by *Frulla*, for the purpose of making the user interface more convenient and efficient for a user to input information and commands in situations in which using a physical mouse is impractical or cumbersome." (Final Office Action, pages 7-8). Applicants respectfully submit, however, that the provided motivations do not provide a suggestion to combine these three references.

Specifically, and as stated above, *Mitchell* is limited to a speech recognition engine that is used in data processing. (Column 1, lines 8-10). The principle and purpose of the speech recognition engine disclosed in *Mitchell* is to allow "audio data to be played back for any output data which has been dictated even if the data as a whole has been processed in such a way as to move, reorder, delete, insert or format the data." (Column 1, lines 59-67). Thus, *Mitchell* is merely a modification of existing dictating software such as DragonDictate and merely replays dictated text to help a user performing proofreading functions. This objective is very different from the objective of *Dionne*, which is to provide a speller feature that "assists people with dyslexia by reinforcing the appearance of the letters one at a time in the string as the letters are being pronounced by the speller 60." (Column 4, lines 10-13). In the Final Office Action, the Examiner states that "*Dionne* specifically teaches that the system is useful in assisting individuals with learning disabilities or severe visual impairments, and one of ordinary skill would clearly recognize the desirability of providing such individuals with text editing assistance so as to have a reading machine spell a word and provide an text-to-speech output of the word." (Final Office Action, pages 8-9). However, according to *Mitchell*, the speech recognition engine displays the dictated and revised text to a user on a monitor as it is being played back to the user. Thus, to the extent that it is desired, the spelling of the word is provided to the user on the monitor. Neither reference provides any suggestion as to how providing an auditory spelling of a word to a user of the speech recognition engine of *Mitchell*

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such an argument. If the Examiner relies on personal knowledge to supply the required motivation or suggestion to combine or modify the references, Applicants respectfully request that the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

would be advantageous in performing proofreading functions. Accordingly, Applicants respectfully submit that one of ordinary skill in the art at the time of Applicants' invention would not have been motivated to combine the disclosure of *Mitchell* with the disclosure of *Dionne*. It is clear based at least on the many distinctions discussed above that the proposed *Mitchell-Dionne-Frulla* combination does not, taken as a whole, suggest the claimed invention, taken as a whole. Applicants respectfully submit that the Examiner has merely pieced together disjointed portions of unrelated references, with the benefit of hindsight using Applicants' claims as a blueprint, in an attempt to reconstruct Applicants' claims.

For at least these reasons, Applicants respectfully submit that the proposed *Mitchell-Dionne-Frulla* combination is improper.

### **III. Arguments Not Responded to in the Final Office Action**

In the Response to Office Action submitted on September 22, 2005, Applicants argued that *Mitchell* does not disclose, teach, or suggest "for each audio file, storing information relating the audio file to the corresponding textual word, the information comprising an electronic marker within the audio file that indicates the position of the audible word within the text file," as recited in independent Claim 35. Although the Examiner did not respond to Applicant's arguments in the Response to Office Action mailed September 22, 2005, it appears that the Examiner continues to rely upon *Mitchell* for disclosure of the recited features. Applicants believe, however, that Applicants' previous arguments continue to have merit. Thus, Applicants reiterate Applicants' arguments made with regard to *Mitchell* in the previous Response to Office Action. Specifically, although *Mitchell* discloses that "each of the words recognized is identified by an identifier tag which identifies the position in the sequence of word[s]," the identifier tag of *Mitchell* is merely an entry within the "information files [that] are generated containing information" related to an audio data file. (Column 6, lines 50-55.) Specifically, *Mitchell* discloses that "two files are stored by the speech recognition engine application 11 which includes the information illustrated in tabular form in FIG. 3." (Column 5, lines 48-51). The two files include the identifier tag and an audio start point and audio endpoint. (Figure 3). By disclosing that the identifier tag of *Mitchell* is included in the data file rather than the audio file, the identifier tag of *Mitchell* cannot be considered the equivalent of

"an electronic marker within the audio file that indicates the position of the audible word within the text file," as recited in independent Claim 35.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claim 35, together with Claim 36 that depends from Claim 35.

**CONCLUSION**

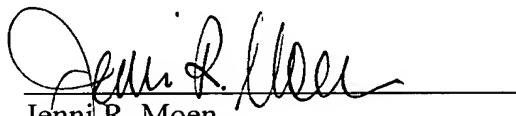
Applicants have made an earnest attempt to place this application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorneys for Applicants, at the Examiner's convenience at (214) 953-6809.

Applicants believe that no fees are due, however, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,

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